

REMARKS

The pending claims in the application are claims 1-3, 5-27, and 29-30. Claims 11, 17, 21, 22, 25-27, 29, and 30 have been withdrawn from consideration. In the response Applicant has amended claim 1 to include the element of claim 4 and amend claims 5 and 10 to reflect the cancellation of claim 4. Claim 19 was amended to narrow the use of the sintered and compacted particles to form the cutting member surface. Support for such amendment may be found in claim 4 as well as in paragraphs 9, 16, and 36 of the application.

In the response, the Applicant has not raised new issues that would require further search or consideration by the Examiner. The issue of new matter has not been raised. The response does not present additional claims without canceling a corresponding number of finally rejected claims and it does place the application in better condition for appeal by materially reducing or simplifying the issues for appeal.

The Office Action

Claim Objection

In the December 12, 2006 office action, the Examiner objected to claim 28. Applicant respectfully disagrees. However, to expedite prosecution, Applicant has canceled the claim from the application.

35 U.S.C. § 102 Claim Rejection

The Examiner rejected claims 1-3 and 12 under 35 U.S.C. § 102(b) as being anticipated by Wright and claims 1-3 and 12-14 under 35 U.S.C. § 102(b) as being anticipated by Raetz.

Applicant has amended independent claim 1 to include the limitation of claim 4, which on page 6 of the action, the Examiner admits that neither Wright nor Raetz disclose the element of claim 4. Given the amendment to claim 1 and the Examiner's early comment, Applicant states the ground for rejection is now moot and respectfully requests that the ground for rejection is withdrawn.

35 U.S.C. §103 Claim Rejection

In the action, the Examiner rejected claim 28 as being obvious in view of Raetz. For the reason that Applicant has canceled the claim from the application, Applicant respectfully states that the rejection is now moot and asks that it is withdrawn.

The Examiner also rejected claims 4-10, 15, 16, 18, 19, 23, and 24 as being unpatentable over one of Wright or Raetz in view of Funakubo and anyone of several other references. According to the Examiner, each of Wright and Raetz lack at least one claim element of claims 4-10, 15, 16, 18, and 19. As for claim 4, the Examiner rejected the claim on the combination of references of Wright or Raetz with Funakubo. The Examiner alleged that Funakubo includes an example which teaches many of the materials set forth in the above claims and that these materials are used for their known benefits including improved durability and strength characteristics. The Examiner then opined that it would have been obvious to one of ordinary skill in the art to use the subject materials to make the cutters of Wright and Raetz.

To establish a *prima facie* case, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. See *Karsten Mfg. Corp. v. Cleveland Gulf Co.*, 242 F.3d 1376, 1385, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention."); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding"). *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 934, 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor."); *Abbott Laboratories v. Syntron Bioresearch, Inc.*, 334 F.3d 1343, 67 U.S.P.Q.2d 1337 (Fed. Cir.), *reh'g*

denied, 2003 U.S. App. LEXIS 17605 (2003) ("Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render claim obvious. The issue is whether substantial evidence supports the judgment (under the clear and convincing evidence standard) that a person having ordinary skill in the art would not have been motivated to replace the [prior art process] with [the process of the invention]."). The teachings or suggestions, as well as the second requirement, expectation of success, must come from the prior art, not applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. In other words, a hindsight analysis is not allowed. See *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991) (While the idea of using a monkey gene to probe for a homologous human gene may have been "obvious to try," many pitfalls existed that would have eliminated a reasonable expectation of successfully obtaining the EPO gene. "Hindsight is not a justifiable basis on which to find that ultimate achievement of a long sought and difficult scientific goal was obvious.").

Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims. See *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

Applicant agrees with the Examiner that neither Wright nor Raetz teach, suggest, or disclose the following claim element: "wherein said surface having the second taper constructed from sintered and compacted particles of abrasion resistant material." As for Funakubo, it does not teach the claim element either, nor does it suggest or motivate one of ordinary skill in the art to make the surface which mates with the base member from sintered and compacted particles of abrasion resistant material. At best, Funakubo only suggests or motivates the person of ordinary skill in the art to modify the teachings of Wright and Raetz to use such materials as the cutting tip of the cutting element of both Wright and Raetz. Funakubo provides no motivation for using such materials as an

internal mating surface. For this reason the claims of the application are patentable over the combination of references. Applicant respectfully requests that the rejection to the claims is withdrawn.

Additionally Applicant states that the subject matter of the claims of the application are unobvious for the reason that an indicia of unobviousness of the claimed subject matter is also present in this matter. Applicant has attached exhibit A to the response. Exhibit A is a publicly available document regarding the History Channels "Invent Now Challenge" as part of its Modern Marvels program. The Challenge seeks to recognize and celebrate the "ingenuity, imagination, and invention brought to life" by unrecognized independent inventors throughout the country. In the 2005 to 2006 competition it is reported that over 4,500 inventions were submitted. A hundred inventions were chosen as honorable mention of which 25 were chosen as semi-finalists, 4 as finalists, and 1 eventual winner.

Once again the challenge has received thousands of submissions. As indicated on page 11 of the alphabetical listing of inventors, David Szymanski the inventor herein, was recognized as one of the top 100 hundred inventors for the subject matter of the claims pending herein. Thus, after reviewing thousands of submissions, the claimed subject matter was viewed to be one of the top one hundred concepts in terms of ingenuity, imagination, and inventive quality by an independent inventor in the last year.

As such, Applicant respectfully states that exhibit A rebuts the *prima facie* showing of obviousness and that the pending claims are patentable over the cited combination of references.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-3, 5-10, 12-16, 18-20, 23, and 24) are now in condition for allowance.

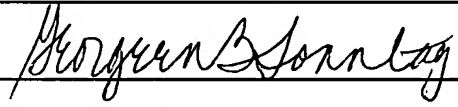
Respectfully submitted,

FAY SHARPE LLP

January 26, 2007
Date



Timothy R. Krogh, Reg. No. 40,688
1100 Superior Avenue, Seventh Floor
Cleveland, OH 44114-2579
216-861-5582

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